

ORRICK, HERRINGTON & SUTCLIFFE LLP
KAREN G. JOHNSON-MCKEWAN # 121570
kjohnson-mckewan@orrick.com
ANNETTE L. HURST # 148738
ahurst@orrick.com
GABRIEL M. RAMSEY # 209218
gramsey@orrick.com
405 Howard Street
San Francisco, California 94105-2669
Tel: (415) 773-5700/Fax: (415) 773-5759

PETER A. BICKS (pro hac vice)
pbicks@orrick.com
LISA T. SIMPSON (pro hac vice)
lsimpson@orrick.com
51 West 52nd Street
New York, New York 10019-6142
Tel: (212) 506-5000/Fax: (212) 506-5151

ORACLE CORPORATION
DORIAN DALEY # 129049
dorian.daley@oracle.com
DEBORAH K. MILLER # 95527
deborah.miller@oracle.com
MATTHEW M. SARBORARIA # 211600
matthew.sarboraria@oracle.com
RUCHIKA AGRAWAL # 246058
ruchika.agrawal@oracle.com
500 Oracle Parkway
Redwood City, CA 94065
Tel: (650) 506-5200/Fax: (650) 506-7117

Attorneys for Plaintiff
ORACLE AMERICA, INC.

KEKER & VAN NEST LLP
ROBERT A. VAN NEST - # 84065
rvannest@kvn.com
CHRISTA M. ANDERSON - # 184325
canderson@kvn.com
DANIEL PURCELL - # 191424
dpurcell@kvn.com
633 Battery Street
San Francisco, CA 94111-1809
Telephone: (415) 391-5400
Facsimile: (415) 397-7188

KING & SPALDING LLP
BRUCE W. BABER (pro hac vice)
bbaber@kslaw.com
1185 Avenue of the Americas
New York, NY 10036
Tel: (212) 556-2100
Fax: (212) 556-2222

Attorneys For Defendant
GOOGLE, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC. ,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

Case No. CV 10-03561 WHA

**JOINT [PROPOSED] FINAL PRETRIAL
ORDER**

Dept. Courtroom 8, 19th Fl.
Judge: Hon. William Alsup

Trial date: May 9, 2016

JOINT [PROPOSED] FINAL PRETRIAL ORDER

Pursuant to the Court’s Guidelines for Trial and Final Pretrial Conference in Civil Jury Cases and the Federal Rules of Civil Procedure, the parties submit the following Joint Proposed Pretrial Order.

I. CLAIMS AND DEFENSES THAT REMAIN TO BE DECIDED

Oracle asserts claims against Google for infringement of Oracle’s copyrights in Java 2 Standard Edition (“J2SE”) Version 1.4 and Java 2 Standard Edition 5.0 (“the Asserted Works”). There are 37 Java API packages at issue in this case. The Federal Circuit has “concluded that the declaring code and the structure, sequence, and organization of the 37 Java API packages at issue are entitled to copyright protection” and remanded “with instructions to reinstate the jury’s infringement verdict,” and for a new trial on Google’s fair use defense. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1381 (Fed. Cir. 2014), *cert. denied*, 135 S.Ct. 2887 (2015). The Court has stated that it will instruct the jury that “all agree and it has been established that the Android versions in play (Android 1.0, Android 1.1, Cupcake, Donut, Eclair, Froyo, Gingerbread, Honeycomb, Ice Cream Sandwich, Jelly Bean, KitKat, and Lollipop, including major and minor releases thereof) used the copyrighted declaring code and the structure, sequence, and organization of the 37 Java API packages at issue and that this constituted infringement unless Google carries its burden before our jury as to the defense of fair use.” ECF 1488 at 2-3. The parties later agreed, and the Court ordered, that “Marshmallow shall be added to the named versions of Android to be in play at the trial.” ECF 1506 at 2. Pursuant to paragraph 2(a) of the Court’s Guidelines, the parties provide below a further “brief description of the substance of the claims and defenses which remain to be decided.”

Oracle’s Statement: The declaring code and structure, sequence, and organization (“SSO”) of the 37 Java API packages have already been found to be copyrightable and infringed by Google. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d at 1381. The remaining issues to be tried to a jury are: Google’s fair use defense, whether Google’s infringement was willful, and Oracle’s claim for damages.

Google's fair use defense fails. Google intentionally, and with knowledge of Oracle's

1 copyrights, copied Oracle's declaring code and the structure, sequence, and organization of the 37
 2 Java API packages for what Google conceded were purely commercial reasons. Google copied
 3 significant portions (measured both quantitatively and qualitatively) of creative and expressive
 4 elements of Oracle's copyrighted work, and did so without transforming the expression, meaning,
 5 or purpose of the copied material. Google's copying has caused substantial harm to the actual
 6 and potential market for and the value of the copyrighted works and their derivatives. Moreover,
 7 if use akin to Google's were to become widespread and unrestricted, it would substantially impair
 8 the actual and potential market for and value of the copyrighted works and their derivatives.
 9 Google's infringement is willful and was specifically intended to enable Android to take
 10 advantage of the widely successful, preexisting ecosystem of Java developers, OEM, and carriers,
 11 thereby allowing Android to rapidly gain a significant commercial foothold. Google's
 12 infringement resulted in Google appropriating for itself the substantial benefits of the Java
 13 platform while undermining the value of the Java platform and its derivatives in the marketplace.

14 Next, Google's only remaining equitable defenses are equitable estoppel and laches.
 15 Equitable estoppel does not apply because Google cannot meet its burden to prove that Oracle
 16 knew of Google's infringement, Oracle took steps intended to convey that it assented to Google's
 17 infringement, Google was ignorant of Oracle's objection, and Google relied on Oracle's
 18 statements and conduct to Google's detriment. With regard to laches, Google cannot prove that
 19 Oracle delayed bringing this suit, much less that Oracle delayed for an unreasonable length of
 20 time; nor can Google demonstrate that it suffered prejudice as a consequence of any alleged
 21 delay.

22 **Google's Statement:** Google's use of the structure, sequence, and organization ("SSO") /
 23 declarations of the 37 Java API packages as one minor part of the Android smartphone operating
 24 system was and is a fair use under 17 U.S.C. § 107. Android is a transformative use, which
 25 Sun/Oracle applauded and welcomed. Google's use also was consistent with Sun/Oracle's
 26 business model of promoting the free and widespread use of the Java programming language and
 27 the associated API packages, including by way of independent implementations. The
 28 SSO/declarations are functional, and are a minor part of the Asserted Works. Finally, Google's

1 use of the SSO/declarations did not harm the actual or potential market for the Asserted Works or
 2 any applicable derivative works. Rather, Google's use has benefited the Java programming
 3 language, and was consistent with Sun/Oracle's Java business model. Accordingly, Google's use
 4 was a fair use under 17 U.S.C. § 107 and thus non-infringing under copyright law.¹

5 Oracle's claims and/or relief sought are barred by the doctrine of equitable estoppel.
 6 Sun/Oracle knew of Google's alleged infringement, and engaged in actions, inactions, and a
 7 course of conduct demonstrating that Google's use of the SSO/declarations was permissible and
 8 approved by Sun/Oracle. Google reasonably relied on such actions, inactions, and conduct to its
 9 injury or material harm. Oracle's claims and/or relief sought are also barred by the doctrine of
 10 laches. Sun/Oracle delayed in filing a lawsuit for an unreasonably long and inexcusable period of
 11 time, and Google has been or will be prejudiced in a significant way by such delay.

12 II. RELIEF SOUGHT

13 Oracle seeks the following relief:

- 14 1. A judgment holding that Google is liable for infringement of the copyrights at issue as to
 15 all Android releases through Marshmallow;
- 16 2. An award of actual damages resulting from Google's infringement of Oracle's copyrights
 17 as well as an award of Google's profits attributable to the infringement of Oracle's
 18 copyrights (to the extent the profits are not duplicative of actual damages), together with
 19 prejudgment and post-judgment interest;
- 20 3. An award of statutory damages that accounts for Google's willful infringement of
 21 Oracle's copyrights;
- 22 4. A permanent injunction, the precise contours of which Oracle will formulate at the
 23 commencement of Phase III, generally enjoining Google, its officers, agents, servants,
 24 employees, attorneys, affiliated companies, assigns and successors in interest, and all
 25 others in active concert or participation with Google (including Original Equipment
 26 Manufacturers ("OEMs"), Original Device Manufacturers ("ODMs"), and Carriers), from

27 ¹ Google does not waive and hereby expressly preserves its position that the SSO/declarations are
 28 not protected by copyright law. *See, e.g., Bikram's Yoga Coll. of India, L.P. v. Evolation Yoga, LLC*, 803 F.3d 1032 (9th Cir. 2015). Because the upcoming trial will not address the issue of
 copyrightability, Google does not further address that issue in this submission.

1 directly, indirectly or vicariously infringing the copyrights in suit, or inducing, causing or
 2 materially contributing to infringement of the copyrights in suit;

3 6. An award of attorneys' fees and costs under 17 U.S.C. § 505; and

4 7. Any other legal and equitable relief as may be available under the law and which the
 5 Court may deem proper.

6 **Google seeks the following relief:**

7 1. Judgment that Oracle's claims are barred by the defense of fair use;

8 2. A declaration that Oracle's claims and/or the relief it seeks are barred, in whole or in part,
 9 by the doctrines of equitable estoppel and laches;

10 3. Judgment dismissing Oracle's claims against Google with prejudice;

11 4. Judgment that Google is the prevailing party;

12 5. Judgment that Google is entitled to attorney's fees and costs; and

13 6. Such other and further relief to Google as the Court may deem just and proper.

14 **III. STIPULATED FACTS**

15 The parties stipulate to the following facts:

16 1. Oracle America, Inc. ("Oracle") is a corporation organized under the laws of the State of
 17 Delaware with its principal place of business at 500 Oracle Parkway, Redwood City,
 18 California 94065. Oracle does business in the Northern District of California.

19 2. Google Inc. ("Google") is a corporation organized under the laws of the State of Delaware
 20 with its principal place of business at 1600 Amphitheatre Parkway, Mountain View,
 21 California 94043. Google does business in the Northern District of California.

22 3. On January 27, 2010, Oracle Corporation acquired Sun Microsystems, Inc. ("Sun"). Sun is
 23 now Oracle America, Inc., a subsidiary of Oracle Corporation.

24 4. Sun registered with the U.S. Copyright Office the Java 2 Standard Edition ("SE") Version
 25 1.4.

26 5. Sun registered with the U.S. Copyright Office the Java 2 Standard Edition (again "SE")
 27 Version 5.0.

28 6. Oracle makes no claim for the protectibility under copyright of the Java programming

language, in and of itself.

7. Oracle is the owner of the copyrights in Java 2 SE 1.4 and Java 2 SE 5.0.

IV. FACTUAL ISSUES THAT REMAIN TO BE TRIED BY THE JURY

Below are the factual issues to be tried. The issues labeled “JOINT” are factual issues that both parties agree remain to be tried. The issues labeled “GOOGLE” are proposed solely by Google as factual issues remaining to be tried, and issues labeled “ORACLE” are proposed solely by Oracle as factual issues remaining to be tried.

- **JOINT:** Whether Google’s use of the declaring code and structure, sequence, and organization of the 37 Java API packages constitutes a fair use. This issue includes, but is not limited to, the following list of non-exhaustive factors:
 - a. The purpose and character of the use;
 - b. The nature of the copyrighted work;
 - c. The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
 - d. The effect of the use upon the potential market for or value of the copyrighted work.
- **JOINT:** Whether and what amount of actual damages Oracle is entitled to, if any, if fair use is not found.
- **JOINT:** Whether and what amount of statutory damages Oracle is entitled to if fair use is not found.
- **ORACLE:** Whether and what amount of Google’s profits attributable to the copyright infringement Oracle is entitled to if fair use is not found. (As explained more fully in the trial brief submitted concurrently herewith, Oracle submits that this question is generally a question for the jury, and that it is especially so in this specific case.)
- **JOINT:** Whether, if fair use is not found, Google’s infringement was willful.

V. ISSUES WHICH REMAIN TO BE RESOLVED BY THE COURT

Below are the equitable issues to be tried to the Court. The issues labeled “JOINT” are issues that both parties agree remain to be tried by the Court. The issues labeled “GOOGLE” are

1 proposed solely by Google as equitable issues remaining to be tried, and issues labeled
 2 “ORACLE” are proposed solely by Oracle as equitable issues remaining to be tried.

- 3 • JOINT: Whether Oracle’s claims or relief sought are barred in whole or in part by the
 4 doctrine of equitable estoppel.
- 5 • JOINT: Whether Oracle’s claims or relief sought are barred in whole or in part by the
 6 doctrine of laches.
- 7 • GOOGLE: The amount of Google’s profits attributable to the alleged copyright
 8 infringement that Oracle is entitled to, if any, if infringement is found. (“Disgorgement of
 9 unjust gains” under the Copyright Act is a form of “equitable relief,” *Petrella v. Metro-*
 10 *Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977-78 (2014), and therefore must be resolved by
 11 the Court. As Google previously stated when this issue was raised after remand, Google
 12 does not concede that Oracle has a right to a jury trial on its claim for disgorgement of
 13 profits, which the Supreme Court characterized in *Petrella* as an equitable remedy. ECF
 14 1302 (“To be clear, and as is evident from Google’s separate submission regarding the
 15 equitable defense of laches, Google does not concede that Oracle has a right to a jury trial
 16 on its claim for disgorgement of profits, which the Supreme Court characterized in
 17 *Petrella* as an equitable remedy...Google welcomes the opportunity to brief this issue in
 18 full as part of a separate motion, if and when the Court desires.”). This issue does not
 19 affect what will be determined by the jury in the fair use phase of the trial under the
 20 Court’s present trial schedule, but will affect the issues submitted to the jury during any
 21 damages phase.).
- 22 • ORACLE: Whether Oracle is entitled to a permanent injunction enjoining Google, its
 23 officers, agents, servants, employees, attorneys, affiliated companies, assigns and
 24 successors in interest, and all others in active concert or participation with Google, from
 25 directly, indirectly, or vicariously infringing the copyrights in suit, or inducing, causing, or
 26 materially contributing to infringement of the copyrights in suit.

27 **VI. REQUEST FOR RESPONSE RE REFERENCES TO PRIOR PROCEEDINGS**

28 On April 18, 2016, the Court requested that the parties “state the extent to which any

1 aspect of the proceedings before the Federal Circuit should be admitted or referenced before our
 2 jury, including recordings of the oral argument and statements made in the opinion of the
 3 appellate court.” ECF 1683. The Court further requested that the parties “[p]lease also state the
 4 extent to which testimony and verdicts from the first trial should be presented to the jury and any
 5 objections thereto.” *Id.* The parties have conferred and reached agreement regarding certain
 6 aspects of the Court’s request. The parties set forth below the scope of their agreement, as well as
 7 separate statements indicating the issues upon which they disagree.

8 **Joint Statement:** The parties agree that the Court need not and should not inform the jury
 9 regarding the procedural history of the case. The Court should inform the jury only that Oracle
 10 filed this lawsuit against Google on August 12, 2010. The Court should not reference the prior
 11 trial or appeal. The parties also agree that they will not present evidence or argument regarding
 12 the prior trial or appeal unless and until either party opens the door to such evidence or argument,
 13 and after prior clearance with the Court.

14 The parties further agree that testimony given in the prior trial should be admissible to the
 15 same extent that testimony given in depositions taken in this case would be admissible at trial. In
 16 using prior testimony at trial, the parties agree to refer to the testimony generally as “prior sworn
 17 testimony” and not identify the testimony as having been elicited at a prior trial.

18 **Oracle’s Statement:**

19 In addition to the above agreed statement, Oracle submits that for all matters that the
 20 Federal Circuit or this Court has determined or deemed undisputed or admitted, including: (1) that
 21 “the Android versions in play . . . used the copyrighted declaring code and the structure,
 22 sequence, and organization of the 37 Java API packages at issue and that this constituted
 23 infringement unless Google carries its burden . . . as to the defense of fair use,” ECF No. 1506;
 24 (2) that Google copied portions of the API packages for “purely commercial purposes,” *Oracle*
 25 *Am., Inc. v. Google Inc.*, 750 F.3d at 1376; and (3) that the declaring code and the structure,
 26 sequence, and organization of the API packages are “both creative and original,” *id.* at 1365, the
 27 Court should instruct the jury as to those matters (as previously explained in connection with the
 28 jury instruction briefing). Concurrent with this filing, Oracle will submit a request that the Court

1 deem facts admitted for the purposes of instructing the jury. It should be noted that Google's
 2 counsel has twice admitted the commerciality of Google's use of Android: once before the
 3 Federal Circuit and once to this Court:

4 JUDGE O'MALLEY: But for purpose and character, though, you
 5 don't dispute that it was entirely a commercial purpose.

6 VAN NEST: No.

7 Oral Arg., *Oracle Am., Inc. v. Google Inc.*, Nos. 2013-1021, -1022 (Fed. Cir.) at 1:02:54-1:03:00,
 8 available at <http://oralarguments.ca9.uscourts.gov/default.aspx?fl=2013-1021.mp3>.

9 I mean, again, the fact that it's a commercial use is not in dispute.
 10 Nobody is claiming that Google created Android as part of a
 11 charitable mission. The evidence is pretty clear that they created it
 to provide a platform on which other Google product[s] could do
 better.

12 Tr. 1418:15-20. These statements are judicial admissions, *United States v. Crawford*, 372 F.3d
 13 1048, 1055 (9th Cir. 2004) (en banc), and are "binding on both the parties and the court," *United*
 14 *States v. Davis*, 332 F.3d 1163, 1168 (9th Cir. 2003). See also *Hilao v. Estate of Marcos*, 393
 15 F.3d 987, 993 (9th Cir. 2004) ("A party . . . is bound by concessions made in its brief **or at oral**
 16 **argument.**") (emphasis added); *In re Crystal Props., Ltd., L.P.*, 268 F.3d 743, 752 (9th Cir. 2001)
 17 (same). Google's admissions have "the effect of withdrawing [the] fact from issue and
 18 dispensing wholly with the need for proof of the fact." *American Title Ins. Co. v. Lacelaw Corp.*,
 19 861 F.2d 224, 226-27 (9th Cir. 1988).

20 If the Court will not instruct the jury that certain issues, such as commerciality, are not in
 21 dispute, then Oracle reserves its right to present Google's counsel's admissions on those points as
 22 opposing party's statements under Federal Rules of Evidence 801(d)(2)(C) and (D). See, e.g.,
 23 *Totten v. Merkle*, 137 F.3d 1172, 1176 (9th Cir. 1998) ("Under the federal rules, a statement made
 24 by an attorney is generally admissible against the client."); *Peace & Freedom Party v. Bowen*,
 25 912 F.Supp.2d 905, 907 (E.D. Cal. 2012) (deeming an attorney's statement "judicially noticeable
 26 non-hearsay" under Federal Rules of Evidence 801(d)(2)(C) and (D)); *Synthes USA, LLC v.*
 27 *Spiral Kinetics, Inc.*, 2011 U.S. Dist. LEXIS 126844, *14-16 (N.D. Cal. 2011) (denying a motion
 28 *in limine* to exclude attorney statements). The transcripts containing such statements, which are

1 certified by court reporters, as well as the official audio recordings of those statements, are self-
2 authenticating documents under Federal Rule of Evidence 902(4). *Ball v. A.O. Smith Corp.*, 451
3 F.3d 66, 71 (2d Cir. June 9, 2006). Again, Oracle will reference these statements only as prior
4 attorney admissions on behalf of Google, and will avoid specifically referencing the Federal
5 Circuit proceedings. Given that counsel's admission before the Federal Circuit was in response to
6 a question by Federal Circuit Judge O'Malley, we believe the Court can fashion an appropriate
7 explanation without going into the details of the Federal Circuit proceedings in the case. All of
8 this can be avoided if counsel stipulates to what has already been admitted: that Android copied
9 the design of the API packages for "entirely a commercial purpose."

10 **Google's Statement:**

11 Based on the Federal Rules of Evidence, and in particular Rules 401, 402, 403, 801, and
12 802, Google disagrees with Oracle's suggestion that background statements cherry-picked from
13 the Federal Circuit's opinion should be deemed "undisputed facts." The Federal Circuit did not
14 purport to engage in any fact-finding. *See generally Oracle America, Inc. v. Google Inc.*, 750
15 F.3d 1339 (Fed. Cir. 2014). Nor could it. "Appellate courts review district court judgments; we
16 do not find facts." *Golden Bridge Tech., Inc. v. Nokia, Inc.*, 527 F.3d 1318, 1323 (Fed. Cir.
17 2008); *see also Shawmut Bank, N.A. v. Kress Assoc.*, 33 F.3d 1477, 1504 (9th Cir. 1994). To the
18 contrary, in many instances, the Federal Circuit expressly adopted and relied upon the factual
19 findings that this Court made and which Oracle has never challenged on appeal. *See id.* at 1349
20 ("The district court found, and Oracle concedes to some extent, that three of those packages—
21 java.lang, java.io, and java.util—were 'core' packages, meaning that programmers using the Java
22 language had to use them 'in order to make any worthwhile use of the language.'" (citing ECF
23 1202 (Order re Copyrightability of Certain Replicated Elements of the Java Application
24 Programming Interface)); *see also id.* at 1368 ("And, the [district] court concluded that 'Google
25 replicated what was necessary to achieve a degree of interoperability—but no more, taking care,
26 as said before to provide its own implementations.'").

27 Furthermore, the statements Oracle cherry-picks from the Federal Circuit opinion are
28 entirely one-sided. Oracle ignores the statements that would be harmful to its case, such as the

1 Federal Circuit’s unequivocal statement that “Sun/Oracle has never successfully developed its
 2 own smartphone platform using Java.” 750 F.3d at 1350. *See also id.* at 1350 (“It is undisputed
 3 that the Java programming language is free for anyone to use.”); *id.* at 1351 (“It is undisputed . . .
 4 that Google wrote its own implementing code.”); *id.* at 1368 (“Oracle concedes that Google and
 5 others could employ the Java language—much like anyone could employ the English language to
 6 write a paragraph without violating the copyrights of other English language writers. And, that
 7 Google may employ the ‘package-class-method’ structure much like authors can employ the same
 8 rules of grammar chosen by other authors without fear of infringement.”).

9 Google also disagrees with Oracle’s assertion that statements made by counsel at oral
 10 argument should be deemed undisputed facts or evidence admissible in front of the jury. First,
 11 the statement at issue here is not a judicial admission. Judicial admissions are typically only
 12 found where a deliberate, clear and unambiguous statement is made in a pleading, not where, as
 13 here, counsel responds to a question from the Court about what is or is not in dispute. *See* 2
 14 McCormick On Evid. § 254 (7th ed.) (“[Judicial admissions] are formal concessions in the
 15 pleadings in the case or stipulations by a party or counsel that have the effect of withdrawing a
 16 fact from issue and dispensing wholly with the need for proof of the fact.”) (emphasis added); *see*
 17 *also Robinson v. McNeil Consumer Healthcare*, 615 F.3d 861, 872 (7th Cir. 2010) (“A judicial
 18 admission is a statement, normally in a pleading, that negates a factual claim that the party
 19 making the statement might have made or considered making.”) (emphasis added).

20 Limiting judicial admissions in most instances to statements in pleadings ensures that the
 21 statements are “unequivocal” and “deliberate, clear and unambiguous.” 30B Charles Alan Wright
 22 & Arthur R. Miller, Federal Practice and Procedure § 7026 (2014 ed.). Otherwise, “statements
 23 made by lawyers in opening and closing arguments, in making objections, at side bars, and in
 24 questioning witnesses would be treated as pleadings and searched for remarks that might be
 25 construed as admissions though neither intended nor understood as such. Trials would be turned
 26 into minefields.” *Id.* (citing *Robinson v. McNeil Consumer Healthcare*, 615 F.3d 861, 872 (7th
 27 Cir. 2010). Accordingly, “[o]verall, courts are correctly reluctant to hold [] a statement by
 28 counsel ... to be a judicial admission.” *Id.*

1 **Second**, even if counsel’s statement in oral argument were a judicial admission (it is not),
 2 it is not admissible evidence for the jury at trial. Indeed, “[j]udicial admissions are not evidence at
 3 all but rather have the effect of withdrawing a fact from contention.” 30B Charles Alan Wright &
 4 Arthur R. Miller, Federal Practice and Procedure § 7026 (2014 ed.); see also 2 McCormick On
 5 Evid. § 254 (7th ed.) (“Evidentiary admissions are to be distinguished from judicial admissions.
 6 Judicial admissions are not evidence at all. Rather, they are formal concessions in the pleadings in
 7 the case or stipulations by a party or counsel that have the effect of withdrawing a fact from issue
 8 and dispensing wholly with the need for proof of the fact.”) (emphasis added). None of the cases
 9 cited above by Oracle address a situation where trial counsel’s statement in oral argument about
 10 what is or is not in dispute was admitted as substantive evidence in a subsequent jury trial.

11 Thus, even if the Court were to deem counsel’s statement at oral argument a judicial
 12 admission, that statement could not be submitted as evidence to the jury. Rather, Google would
 13 not be permitted to dispute at trial that its use of the declarations/SSO of the 37 Java SE APIs was
 14 commercial in nature under the first fair use factor. Such an approach is appropriate here where
 15 Google does not intend to dispute commerciality at trial.² This approach further avoids the
 16 improper and prejudicial outcome of injecting trial counsel as a witness in this case.

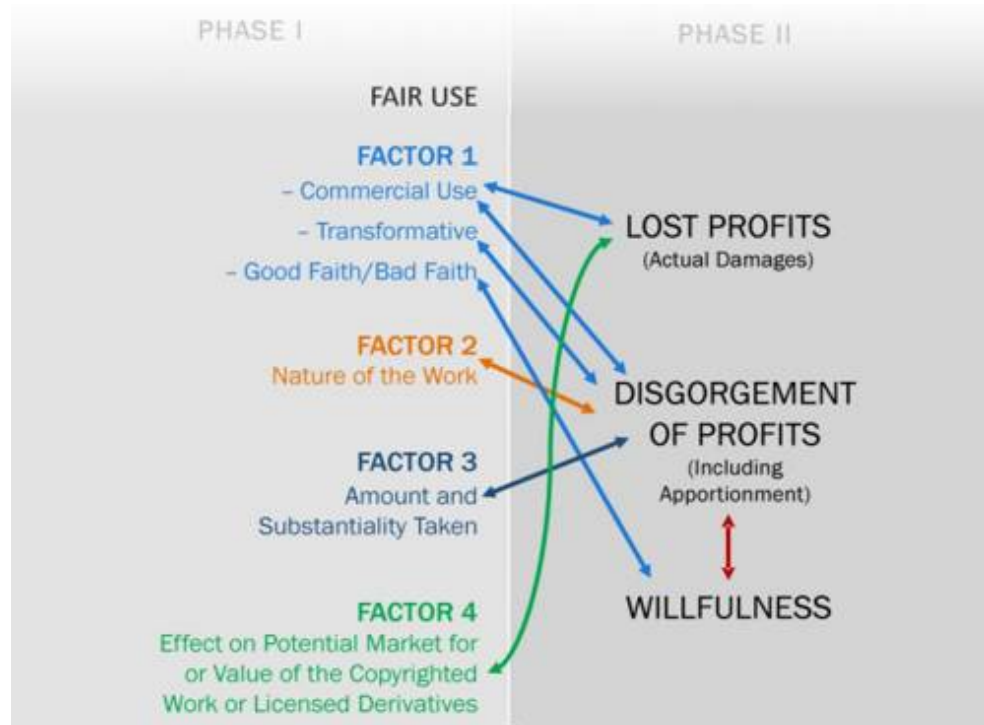
17 In short, Oracle’s selective approach to identification of “undisputed facts” is improper
 18 and unworkable. The Federal Circuit found that there were material facts in dispute regarding
 19 Google’s fair use defense, and it remanded for a jury trial to decide those fact disputes. *Id.* at
 20 1376 (“On balance, we find that due respect for the limit of our appellate function requires that
 21 we remand the fair use question for a new trial.”). Rather than parse the Federal Circuit’s
 22 opinion, this Court’s prior findings of fact, and counsel’s statements in oral argument, briefs, and
 23 the prior trial, the parties should try their case to the jury and let the jury find the facts.

24 **VII. OTHER MATTERS**

25 **Oracle’s Statement:** Oracle hereby renews its request, more fully discussed in ECF Nos.
 26 1504 and 1539, that fair use not be bifurcated from willfulness and damages. Oracle understands

27
 28 ² Google reserves the right to argue, for example, that Android was more transformative than commercial, and thus the first factor favors fair use.

that, as the Court noted last week, sometimes “it would be better to wait and see how [the Court] feel[s] about everything before [it] rule[s] on anything,” because many of the issues in the case “feed into each other.” 4/14/16 Hrg. Trans. At 134:20-25. Oracle reiterates that there is serious overlap between the many issues in this case, as shown in the below graphic.



If the case is to remain bifurcated, Oracle respectfully requests that the Court grant the parties three additional hours apiece for the first phase, and that the parties be able to freely shift hours between the phases.

Google’s Response: For all of the reasons stated in Google’s Response to Oracle’s Argument Regarding Bifurcation (ECF 1543), the Court should adhere to its plan to bifurcate the trial. Bifurcation will assist juror comprehension by reducing the number of issues the jurors are required to resolve at one time, thereby allowing them to focus their attention on the evidence and determinations that are relevant to a particular issue. *See also* ECF 1321 (Order re Willfulness and Bifurcation) at 12-13. As the Court has observed during the hearings held over the last two weeks, the damages issues in this case are extremely complex and time-consuming and are separate from the fair use issues in many respects. Lumping all of these issues together in one unitary proceeding will be confusing for the jury. As just one example, in its fair use case Oracle

1 seeks to argue that Android harmed the market for past and current versions of Java *SE* and its
 2 alleged derivatives in a variety of “potential” markets, yet in its damages case it bases its lost-
 3 profits damages analysis on a single revenue projection for Java *ME* from 2008.

4 Furthermore, while there may be some overlap in the evidence between liability and
 5 damages, that overlap would not result in duplication of evidence under the Court’s trial plan
 6 because evidence admitted in the first phase may be referenced in and relied upon by the parties
 7 in the second phase. ECF No. 1488 at 3.³

8 **VIII. JURY INSTRUCTIONS AND BRIEFING**

9 On April 19, 2016, the Court issued a revised set of proposed jury instructions on fair use
 10 (ECF 1688), and requested that the parties “meet and confer in person and try to agree on . . .
 11 [that] proposal or something close thereto, so as to minimize issues for appeal.” *Id.* at 1. The
 12 Court further requested that the parties “submit your agreed-on version by April 28 at noon,” and
 13 the Court has set a briefing schedule for objections to its proposed fair use instruction. *Id.*

14 Pursuant to the Court’s Guidelines, the parties intend to submit a joint set of proposed jury
 15 instructions on substantive law and separate memorandums of law in support of each parties’
 16 disputed instructions concurrent with the filing of this Joint Proposed Final Pretrial Order. The
 17 jury instructions and briefing submitted herewith do not yet take into account the Court’s recently
 18 revised proposed instructions on fair use, which the parties will address on the timeline set forth
 19 in the Court’s April 19, 2016 proposal (ECF 1688). The parties respectfully reserve their right to
 20 modify their proposed instructions and related briefing in light of the Court’s revised proposal.

21 **IX. EXHIBITS AND WITNESS LISTS**

- 22 • The parties’ Joint Trial Exhibit List is attached as **Appendix A.**
- 23 • Oracle’s witness list for its case-in-chief witnesses is attached as **Appendix B.**
- 24 • Google’s witness list for its case-in-chief witnesses is attached as **Appendix C.**

25
 26 ³ Google does not believe that the graphic included in Oracle’s statement accurately represents
 27 the issues in this case. For example, the Court has already held that willfulness is not relevant to
 28 disgorgement unless the defendant seeks to deduct taxes from its profits. ECF 1321 at 11-12.
 Google has not deducted its taxes, and therefore willfulness has no bearing on any issue other
 than statutory damages. *See id.* at 12. And, as noted above, Google submits that disgorgement of
 profits is an equitable issue to be resolved by the Court. *See supra* at 6.

1
2 Dated: April 20, 2016

ORRICK, HERRINGTON &
SUTCLIFFE LLP

4 By: /s/ Christina Von der Ahe Rayburn

5 KAREN G. JOHNSON-MCKEWAN
6 ANNETTE L. HURST
7 GABRIEL M. RAMSEY
8 PETER A. BICKS
9 LISA T. SIMPSON

Attorneys for Plaintiff
ORACLE AMERICA, INC.

10 Dated: April 20, 2016

KEKER & VAN NEST LLP

11 By: /s/ Robert A. Van Nest

12 ROBERT A. VAN NEST
13 CHRISTA M. ANDERSON
14 DANIEL PURCELL

Attorneys For Defendant
GOOGLE, INC.

ATTESTATION

I, Christina Von der Ahe Rayburn, am the ECF User whose ID and password are being used to file the **JOINT [PROPOSED] FINAL PRETRIAL ORDER**. I hereby attest that Reid Mullen, one of the counsel for Google Inc., has concurred in this filing.

Date: April 20, 2016

/s/ Christina Von der Ahe Rayburn